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# Supreme Court of the United States

MONROE B. LEVOY,
Petitioner,
*against*
STYL-RITE OPTICAL CORPORATION

MONROE B. LEVOY,
Petitioner,
*against*
IDEAL OPTICAL CO., INC.

OCTOBER TERM
1950
No. 570

## PETITION FOR WRIT OF CERTIORARI

EUGENE L. BONDY,
Attorney for Petitioner.

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## PETITION FOR WRIT OF CERTIORARI

MONROE B. LEVOY, the petitioner upon both of the above entitled applications, prays that a writ of certiorari may issue to review a judgment of the United States Court of Appeals for the Second Circuit (R. 286) affirming unanimously a judgment of the United States District Court for the Eastern District of New York (R. 271).

### Opinions Below

The findings of fact and conclusions of law of the District Court are printed at pages 268-270 of the record. The opinion of the District Judge, the Honorable Harold M. Kennedy, is printed beginning with page 258. It also appears in 88 F. Supp. 497. The decision of the Court of Appeals, on the opinion of the District Judge (R. 285), is reported at 185 F. 2d 240. The petitioner sued for infringement of a design patent.

## Jurisdiction

The jurisdiction of this court is invoked under C. 646, 62 Stat. 928; 28 U. S. C. A. 1254, Act of June 25, 1948. The judgment of the Court of Appeals, here sought to be reviewed, is dated November 24th, 1950 and this application is therefore timely.

## Questions Presented

The review which this petitioner seeks is of the law upon facts found by the Court. The questions are:

1. Does the inventive talent displayed by the petitioner in conceiving and executing the design measure up to the requirements of the statute for patent protection?

2. May a characteristic of a design which attracts the eye for its cosmetic appeal as well as for absolute beauty be considered on the question of "original and ornamental"?

3. Does an earlier design by the same inventor, for which his patent application was co-pending and which embodies important characteristics of the patent in suit, constitute an impeding prior art?

4. Is the petitioner's patent invalid for want of invention?

## The Statute Involved

The questions presented involve the construction particularly of Section 73 in Title 35 of the United States Code, Sections 4929 and 4933 of the Revised Statutes as amended. The sections reads:

"§ 73. Patents for designs; how obtained; regulations applicable

Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section 31 of this title, obtain a patent therefor.

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs."

## Statement

In these actions the petitioner sought an injunction against further infringement by Styl-Rite Optical Corporation and Ideal Optical Co., Inc. of U. S. Design Letters Patent No. 147,368 granted to him on August 26, 1947, and an accounting, damages, etc. The patent is printed opposite page 244 of the record. It refers for description to the drawings printed opposite page 245. There is no further oral description.

The object of the patent is a spectacle frame so designed as to be attractively beautiful in itself as well as to conform to the standards of beauty which cosmeticians and "beauticians" had found effective in applying their art to the female face. The result was an article of such

intrinsic beauty that (as the Court found—R. fol. 783) "many women purchased plaintiff's frame even though they did not need glasses, because of a belief that the frames were beautiful, or at least attracted attention". This was a great advantage considering that women usually resist the wearing of glasses, even when needed, because of their unflattering effect (R. fol. 774).

The petitioner considered the principle of cosmetics that the appearance of the female face is improved by having the eyes appear large and the nose foreshortened. This, he found, was accomplished by "beauticians" by plucking the lower surface and the interior ends of the eyebrows. The first of these operations make the brow appear higher and the eye larger; the second widens the space over the nose and tends to foreshorten that feature. Any object, such as a spectacle frame, partaking of these characteristics, would constitute an article of beauty when worn by a woman. The shape and ornamentation itself would be intrinsically beautiful as a concomitant.

With this purpose he designed, after much experiment (R. fol. 773) a spectacle frame which the Court described in the following words (Finding No. 1, R. p. 268):

> "* * * the principal features * * * were: (1) the application of lustrous metallic sleeves to the temple pieces of the frame, and of the same material to the upper and outer portions of the eye-pieces in such wise that plastic and lustrous material alternated, and (2) in leaving a plastic uncovered space over the bridge of the nose wider than the nosepiece itself."

The petitioner's frames "met with an instantaneous and widespread commercial success" (Finding No. 3, R. p. 269).

Plaintiff's product was "novel, ornamental and pleasing in appearance in the opinion of those engaged in the optical trade" (Finding No. 11, R. p. 270).

The defendants "wilfully and deliberately copied it, and infringed the patent, if it was valid" (Conclusion No. 1, R. p. 270). Indeed they immediately produced slavish copies (Finding No. 5, R. p. 269).

The Court concluded, however, that the patent was "invalid for want of invention" (Conclusion No. 2, R. p. 270); it lacked "the divine flash" (fol. 800, R. p. 267); besides, some earlier patents had possessed *some* of the characteristics of the design in suit and a co-pending patent of the petitioner himself (referred to as Jeweled Spec) bore a strong resemblance.

## Specifications of Errors to Be Urged

The Court of Appeals erred:

1. In deciding that the invention of the spectacle frame did not involve such inventive talent as the statute requires;

2. In deciding that an earlier design of the same inventor upon which his patent application was co-pending at the time of the filing of the application at bar constituted prior art;

3. In failing to consider that the secondary beauty imparted by the conformity of the design to a cosmetic pattern tended to render the design "new, original, and ornamental";

4. In considering as prior art, with reference to the integrated beauty and pleasing combination of the design at bar, certain prior patents embodying unintegrated elements of the petitioner's designs;

5. In concluding that the petitioner's patent was invalid for lack of invention.

## Reasons for Granting the Writ

1. The decision of the Court of Appeals, affirming without opinion the District Court, construes Section 73 of Title 35 of the United States Code in such manner as practically to nullify its effect.

2. The decision of the Court of Appeals is in conflict with applicable decisions of this Court.

3. The decision of the Court of Appeals presents the situation of a statute deceptively appearing to offer protection for invention.

WHEREFORE, it is respectfully submitted that this petition should be granted.

Dated: New York, N. Y.,
February 19, 1951.

MONROE B. LEVOY

By Eugene L. Bondy
Attorney for Petitioner

# Supreme Court of the United States

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## BRIEF IN SUPPORT OF WRIT OF CERTIORARI

### Statement

The annexed petition states the jurisdiction of the Court, the questions presented, the statute involved, the specification of errors and references to the opinion below. At least two of the questions presented we consider of general interest for determination.

The primary importance that attaches to this application, we submit, is the need for a definition of the degree of talent in designing necessary to constitute invention for qualification under Section 73 of Title 35 of U. S. C. A.

We believe it is generally recognized by the bar that Title 35, Section 73, of the U. S. C. A. has become practically a dead-letter because of the progressive raising of the standard of talent required by decisions of the lower courts. So far as we can learn, the last time the Second Circuit Court of Appeals held a design patent valid and infringed was in 1926 (*Franklin Knitting Mills,*

*Inc.* v. *Gropper Knitting Mills, Inc.,* 15 Fed. 2d 375; cert. den. 273 U. S. 761). We think this present case to be an instance which should be reviewed, to advise the public whether the "divine flash" test (R. 800) is a proper one in so ephemeral a field as commercial designs.

Of general interest, too, is the question whether elements in diverse earlier patents, among themselves unrelated to each other, and presenting no comparable beauty in themselves, can be counted as prior art against a later patent which embodies them, among others, in a pleasing and beautiful combination.

## Summary of Argument

1. The frame invented by the petitioner displayed inventive talent sufficient to qualify the design for protection under the statute.

2. The existence in prior patents of elements, of no comparable beauty in themselves, cannot be counted as prior art against the pleasing integrated design of petitioner in which those elements constituted a part.

3. An earlier design of the same inventor upon which a patent was co-pending did not constitute prior art.

4. A design is to be judged subjectively and its conformity to the dictates of the cosmetic art should have been considered in deciding whether it was "new, original, and ornamental".

5. The petitioner's patent was not lacking in invention.

## Argument

1. Mr. Justice Douglas has recently (*Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corporation,* decided December 4, 1950, Vol. 95, No. 3 of L. Ed. advance

sheets, December 18, 1950) drawn attention to the fact that the authority of Congress to legislate upon patents depends upon the grant by Section 8 of Article 1 of the Constitution. There the power is given to issue patents "to promote the progress of science and useful arts". The enactment of Section 73 could not conceivably have been in the interest of promoting the progress of science. It must have been intended, if Congress was not to exceed its powers, to promote the "useful arts".

A design in the "useful arts" is a matter of short life. By its nature it presents an appeal to the eye. It is not a machine or device. And the public demands novelty. Although presenting solely an *attractive appearance,* it cannot come under the heading of a work of art. "Genius" or a "divine flash" is the mark of a great artist. Must it apply to designers of silver spoons or eye-glass frames? Was the statute intended to protect Cellini's silver statuettes or rather objects designed for commercial taste and made and sold by the great gross?

A glance at such cases as *Whitney Mfg. Co.* v. *Alvin Silver Co.* (283 Fed. 75) will show what the standard was thirty years ago. The simple designs on page 76 show little evidence of genius, we submit. The general art was recognized as old; the "bevels, panels and beading" were old; but no prior art "produced a handle like this, both as to ornamentation and contour or configuration" (Hough, J., at p. 80).

In the case at bar, it is held against the petitioner that "the general notion of beautifying plastic frames was old in 1946" (R. 261). The "general idea" was "already old" (R. 262). The "Jeweled Spec" frame was close; but that was petitioner's own invention (see 10, *infra*). The "Classic" used paint for contrast instead of raised metal and "the contrasting portion of the eye-pieces was carried to the bridge-piece" (R. 262, fol. 789), thus missing the entire appeal of petitioner's design. And

so, each prior patent is referred to, only to show in the end its failure to anticipate petitioner's integrated, beautiful and successful frame.

But the petitioner is nevertheless relegated to the class of a "highly skilled craftsman" who is the "forgotten man of the patent system" (R. 267, fol. 801). The question urged is whether this should be so in considering design patents. Should not the statute be construed so as to be of practical value or, perhaps, pronounced unconstitutional as in furtherance of the *fine* arts rather than of the "*useful* arts"?

2. The District Court makes no attempt in his opinion to identify the design before him in appearance with early patented designs. The latter employed one or other elements of the petitioner's design as mechanical features; but his product went beyond with purpose born of experiment and presented a novel, beautiful and attractive aspect. (See Findings 6 to 10 inclusive R. 269-70; the "Jeweled Spec" will be treated separately below.) This building of a prior art from old elements, unrelated, was we submit, error. *Ashley* v. *Weeks-Neuman Co.*, 220 Fed. 899, 901.

3. The only prior design that approached the one at bar was "Jeweled Spec"; but it differed in that the idea of a spacing of the lustrous metal on the frame so as to leave the part near the nose free—an essential of the design in suit—was absent. So was the gold sleeve (R. 261, fols. 782-3). It was counted as prior art.

This was error. The first sale of Jeweled Spec was March 18, 1946 (R. 95). The application for a patent on it was filed March 29, 1946. The application was copending with that for the design in suit which was filed May 27, 1947. The petitioners were the same, the inventors the same, this plaintiff (R. 245, 248). The Jeweled

Spec could therefore not be prior art. *General Talking Pictures Corp.* v. *Western Electric Co., Inc.,* 304 U. S. 175, 82 L. Ed. 1273, 58 S. C. 849, especially at page 183 of 304 U. S.

4. The Court aparently disregarded the cosmetic appeal which flowed as a secondary attribute from the spacing and shaping of the frame. It was the design that presented this aspect. It brought itself literally within the classification of "useful arts". Whether this element might be considered was apparently raised by Mr. Justice Bradley at page 450 of *New York Belting and Packing Co.* v. *New Jersey Car Spring Co.,* 137 U. S. 445, 34 L. Ed. 741. Decision was, however, deferred until the question should become necessary to decide.

As an element of "useful arts", we would urge that it be considered.

5. All elements which validate a design patent were, we submit, present: A novel beauty; the pleasing combination which was not anticipated; a useful object that invited acceptance; an extraordinary commercial success; and immediate pirating. What swayed the Court in declaring the patent invalid was the finding of a lack of invention by absence of inventive talent and the presence of prior art. We submit the finding was erroneous.

## CONCLUSION

**Wherefore, it is respectfully submitted that this petition for a writ of certiorari should be granted.**

Eugene L. Bondy,
Attorney for Petitioner.